

58. The method according to claim 50, wherein said award selection comprises an award unit.

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment after final, claims 1-17, 33, 34, 39, and 42-58 will be pending in the application, with claims 1, 3, 6, 11, 33, 34 and 49 being the independent claims. Claims 40 and 41 are sought to be cancelled without disclaimer or prejudice. Claims 1, 3, 6, 11, 33, 34, 39 and 49 are amended in accordance with the personal interview with Examiner Poinvil of December 18, 2001. These changes are believed to introduce no new matter, and their entry is respectfully requested. For at least the reasons provided in the previous Amendments filed June 8, 2001, and July 11, 2001, the new claims are also patentable over the applied documents.

If any portion of the specification or claims were sought to be amended in the foregoing, attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

Based on the above Amendment and the following Remarks, Applicant traverses the rejections and respectfully requests that the Examiner reconsider all outstanding rejections or objections and that they be withdrawn.

Personal Interview

Applicant and applicant's representative respectfully thank Examiner Poinvil for the personal interview he provided on December 18, 2001 during which allowable subject matter and proposed amendments were discussed. Applicant acknowledges the Examiner's comments and appreciates his remarks in the written comments. Applicant submits the above amendments to formalize the proposed amendments discussed at length during the personal interview including the allowable subject matter.

Applicant's invention includes various differences over the applied references of record. Claim 1, as amended (emphasis added) includes, inter alia,

a system for incentive program generation and ***automated award fulfillment***, comprising:
a host computer coupled to a network;
a database accessible from said host computer; and
an ***automated award fulfillment application program*** executable on said host computer for participation in incentive programs of a plurality of providers operative to provide ***sponsor-selected fulfillment*** comprising being:
 operative to provide a ***sponsor-selected specific award unit item***,
 operative to provide said sponsor-selected specific award unit item ***tailored to demographic and psychographic preferences of a sponsor-selected consumer user***, and
 operative to provide a ***sponsor-selected geographic location*** for fulfillment.

Applicant asserts at the very least, claim 39 as amended to include claims 40 and 41 is allowable over the applied art as discussed with the Examiner. Applicant believes that all the claims of the Application, as amended, should now be in a condition for allowance, and thus the Applicant requests that the application be passed to issue.

The Examiner's previously received final rejection is now discussed below.

Rejections under 35 U.S.C. § 102

The Examiner at ¶¶ 1 and 2 rejects claims 1-3, 6, 10-15 17 and 49 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,774,870 (hereafter "Storey"). Applicant traverses the rejection. The present invention differs in several important ways from the Storey reference. Applicant's above amendments should overcome the Examiner's rejections.

Storey is apparently directed to a "fully integrated on-line frequency award program" such as a frequent flier program. The Storey frequency award program allows a consumer user from a web browser to browse an online catalog of awards to select from a preset list of awards to electronically place an order to redeem a ***consumer user designated award*** corresponding to an amount of awarded points. Fulfillment of the award itself is performed manually using a conventional "***fulfillment house***". See Abstract, for example.

The claimed invention, by comparison, sets forth systems and methods for generating an incentive program (such as the program described in Storey) and for providing automated award fulfillment. Unlike Storey which deals with the management of an existing promotional program, the claimed invention is used to *generate new incentive programs* that provide for *automated award fulfillment*. Automated award fulfillment, according to the present invention, *includes sponsor designated or selected redemption* whereby the sponsor of the award may select or determine what award unit (see Specification at page 93, line 9, for example) will be provided to the consumer user, and may designate the location of the redemption (see Specification at page 95, line 20, for example). The selection can also include a specific consumer user selected by the sponsor which can, e.g., be instructed to go to a store to pick up the award unit (See for example page 97, line 14-17). For example, the location may include the geographical location of the retailer, merchant or point of sale (POS) (See for example page 96, lines 2-20). Moreover, the present invention can coordinate the delivery of the award or, alternatively, arrange for retrieval of awards in volumes that permit successful incentive fulfillment programs. Storey, by comparison, describes consumer user designated selection of an award and how to redeem the award and then a manual fulfillment house arranges to deliver the award to the consumer user.

Regarding claims 1 and 3, the Examiner asserts that all elements of claims 1 and 3, are anticipated by Storey. Applicant disagrees. As amended, the “automated award fulfillment application” feature of claims 1 and 3 is not taught or suggested by Storey. Specifically, unlike

Storey, which has the consumer select an award (col. 1, lines 23-25) and merely shifts actual fulfillment to a “fulfillment house” or “directly to a product manufacturer” (col. 10, lines 4 and 5), the claimed invention provides automated award fulfillment, by which, as detailed in the specification, a sponsor of a program designates what award will be provided and the location for redemption by the consumer user. A very detailed overview of retail fulfillment is described in the specification beginning on page 92, line 13 and on page 97, lines 15-20, page 99, line 4 through page 100, line 5, page 93, lines 8-15, page 94, lines 7 through page 96, line 1, and page 96, lines 10-20, and page 97, lines 14-22. Thus, claims 1, 3, 6 and 11 are patentable over Storey.

For at least the reasons described above relating to claims 1 and 3, claims 6, 10-15, 17 and 49, claims 2 and 4, and claims 33, 34, 39 and 42-58 are also patentable. Moreover, e.g., claims 39 (as amended) and 42-58 claim additional features not taught or suggested by Storey.

In similar fashion to claims 1 and 3, independent claims 6, 11, 33, 34, 39 and 49 are clearly directed to automated award fulfillment systems. For at least the reasons above with respect to claims 1 and 3, claims 6 and 11 are patentable. Moreover, applicants disagree with the Examiner’s assertion that col. 7 line 45 to col. 8 line 54 from Storey teach anything related to automatic award fulfillment in the sense used in the present invention. Indeed, Storey teaches away from the type of automatic award fulfillment of the present invention. Storey facilitates flexibility and ease for the *consumer user* regarding the selection and fulfillment of awards, while *the present invention gives such flexibility and ease to the sponsor of the award*, rather

than the consumer. Thus, Storey and the present invention have opposing and mutually exclusive goals.

For at least the reasons discussed above regarding the independent claims, the dependent claims 2, 10, 21-15, 17, are patentable over Storey.

Rejections under 35 U.S.C. § 103

The Examiner at ¶3 rejects claims 4-9 and 16 under 35 U.S.C. §103(a) as being obvious in view of Storey, and 33 and 34 over Storey in view of Goldhaber. Applicant traverses the rejection.

For at least the reasons discussed above with reference to independent claims 1, 3, 6 and 11, claims 4-9 and 16 are patentable over Storey alone, or in combination with Goldhaber. Storey and Goldhaber, alone or in combination, do not teach or suggest all the features of claims 4-9 and 16, as amended, taking account of the claims as amended.

For at least the reasons described above, with reference to independent claims 1, 3, 6 and 11, it follows that dependent claims 4,5, 7-10, and 12-17, as amended, are also patentable over Storey and Goldhaber, alone or in combination.

The Examiner at ¶ 5 acknowledges recognition of a difference between Applicant's claimed invention and the applied references, taken alone or in combination. Applicant has amended the claims as discussed at length during the personal interview and hope that the amendment has placed the application in condition for allowance.

The Examiner at ¶ 6 rejects claims 40-58 under 35 U.S.C. § 103(a) as being unpatentable over presumably the previously applied references Storey and Goldhaber, further in view of Von Kohorn (U.S. Patent No. 5,916,024, hereafter “Von Kohorn”) and Scroggie, et al (US Patent 6,014,634, hereafter “Scroggie”). Applicant traverses the rejection. Applicant’s amendment renders rejection of claims 40 and 41 moot. The applied references, alone or in combination, do not teach or suggest all the features of the remaining claims setting forth the claimed invention.

For at least the reasons described above, with reference to independent claims 1, 3, 6, 11, 33 and 49, all as amended, Applicant asserts that claims 42-58 are also patentable over Von Kohorn, Scroggie, Storey and Goldhaber, alone or in combination.

As discussed at length during the personal interview, Applicant’s invention is patentable over Storey and Goldhaber, in view of Von Kohorn and Scroggie, alone or in combination.

The “automatic fulfillment “ of the present invention goes beyond the type of award fulfillment contemplated and taught by Storey. There are fundamental differences between the present invention and Storey. First, the present invention allows far more flexibility for the *sponsor* of the incentive program to design his award fulfillment program, via various *selections*, see claims as amended. Second, the present invention actually contradicts Storey in that the purpose of Storey is to provide convenience to the consumers, while the object of the present invention is to provide convenience to the *sponsor*. After the designation of the particular award, Storey merely delegates the actual delivery to a “fulfillment house,” whereas the present invention allows the sponsor to coordinate the delivery of the award, or, alternatively, to

designate to the consumer where the award may be retrieved. The addition of Goldhaber does not suggest or teach these fundamental and differences.

Goldhaber is directed to compensating a consumer for paying attention to certain advertisements. As with Storey, Goldhaber does not go beyond consumer selection of an award. The actual coordination of delivery of the award is not taught or suggested in this patent. Moreover, the combination of Goldhaber does not provide motivation to combine itself with Storey.

The examiner has conceded that Storey does not teach or suggest a sponsor. Applicant disagrees that it would have been obvious to include a sponsor, or to combine the reference with other references discussing a sponsor, especially in light of the opposing objects of the two inventions (i.e. Storey is directed to providing ease and flexibility to the customer, while the present invention is directed to providing ease and flexibility to the sponsor of the incentive program).

The Examiner also concedes on page 10 of the office action that a fulfillment application program for associating a fulfillment method is not taught by Goldhaber. Applicant agrees. The Examiner has asserted that Storey discloses such an fulfillment application program. However, as noted above, the present invention contemplates a different meaning of "award fulfillment." Furthermore, the Examiner asserts that it would have been obvious to combine the references based on an alleged motivation of maintaining an account of the users balance and transactions.

Applicant disagrees. The patents are directed to totally different applications and Applicant submits that the examiner has not shown an proper motivation to combine.

Furthermore, consideration of the other applied references Von Kohorn and Scroggie which deal with a reward system with a redemption center and an e-coupon system with fulfillment center add nothing to the previous combination, such that Von Kohorn, Scroggie, Storey and Goldhaber, alone or in combination, also do not teach or suggest all the features of the claimed invention.

Applicants also note that the present invention which deals with sponsor selected fulfillment is different from consumer shopping systems wherein a consumer provides a pickup location for a good purchased by the consumer.

Thus all previously pending claims 1-17, 33, 34, 39 and 42-58 are patentable over the applied references.

Applicant further respectfully points out that the Examiner has not proven his prima facie case of obviousness. As discussed above, the Von Kohorn, Scroggie, Storey, and Goldhaber references, alone or in any combination with one another, do not teach or suggest all of the features of the claimed invention. Further, the Examiner has improperly combined the references. The Examiner has not shown a proper motivation to combine the references to allegedly obtain the claimed invention. The Examiner is using hindsight to combine the references based on the Applicant's Specification. The Examiner must teach a motivation to combine the references to properly prove his prima facie case of obviousness.

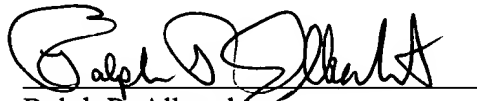
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment is respectfully requested.

Respectfully submitted,

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1. (Twice Amended) A system for incentive program generation and automated award fulfillment, comprising:
 - a host computer coupled to a network;
 - a database accessible from said host computer; and
 - an automated award fulfillment application program executable on said host computer for participation in incentive programs of a plurality of providers operative to provide sponsor-selected fulfillment comprising being:
 - operative to provide a sponsor-selected specific award unit item,
 - operative to provide said sponsor-selected specific award unit item tailored to demographic and psychographic preferences of a sponsor-selected consumer user, and
 - operative to provide a sponsor-selected geographic location for fulfillment.
2. The system of claim 1, further comprising:
 - a client computer of a consumer user coupled to the network;
 - a server coupled to said host computer; and
 - a browser executing on said client computer operative to access content located on said server

wherein the consumer user participates in said incentive programs of the plurality of providers via interaction with said browser.

3. (Twice Amended) A method for generating incentive programs and automating award fulfillment, comprising:

providing a host computer, the host computer having a database and an automated award fulfillment application program;

automating award fulfillment comprising

providing sponsor-selected fulfillment comprising:

providing a sponsor-selected specific award unit item,

providing said sponsor-selected specific award unit item tailored according to demographic and psychographic preferences of a sponsor-selected consumer user, and

providing a sponsor-selected geographic location for fulfillment;

and

permitting access to said database via a network, including allowing participation in incentive programs of a plurality of providers.

4. The method of claim 3, further comprising:

providing a network coupling said host computer to a workstation and being capable of transferring electronic data between said workstation and said host computer;

providing each of said host computer and said workstation with an application program capable of responding to input from said host computer or said workstation;

allowing a user of said host computer to operate said automated award fulfillment application program to generate an incentive program and to store said incentive program on said host computer;

transferring a stored incentive program to said workstation; and

providing an address for said stored incentive program to permit access to said stored incentive program from said network.

5. The method of claim 4, further comprising:

providing at least one of an award association application program that associates an award with said incentive program, and an award fulfillment association application program that associates a fulfillment option with an award.

6. (Twice Amended) A system for automating award fulfillment, comprising:
- a network;
 - a host computer, coupled to said network;
 - a database of said host computer;
 - a browser operative to browse content of said host computer, wherein a consumer user participates in an incentive program;
 - an awards database of awards associated with said incentive program; and
 - an automated award fulfillment application program for automating fulfillment of awards for said incentive program, operative to provide sponsor-selected fulfillment comprising being:
 - operative to provide a sponsor-selected specific award unit item,
 - operative to provide said sponsor-selected specific award unit item tailored to demographic and psychographic preferences of a sponsor-selected consumer user, and
 - operative to provide a sponsor-selected geographic location for fulfillment.
7. The system of claim 6, further comprising:
- a card for fulfillment of awards won in said incentive program.

8. The system of claim 6, further comprising:

a memory operative to store at least a personal identification number associated

with a consumer user.

9. The system of claim 6, further comprising:

memory for storing information relating to participation of said consumer user in
an incentive program.
10. The system of claim 6, further comprising:

a browser, coupled to said host computer, wherein said consumer user participates
in incentive programs of at least two providers via said browser.
11. (Twice Amended) A method for generating incentive programs and
automating award fulfillment, comprising:

providing a host computer;

providing an incentive program on the host computer, wherein a participant may
participate in an incentive program;

providing a database of awards on the host computer associated with the incentive
program; and

providing automated fulfillment of such awards to participants comprising
providing sponsor-selected fulfillment comprising:
providing a sponsor-selected specific award unit item,

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_____ providing said sponsor-selected specific award unit item tailored
according to demographic and psychographic preferences of a sponsor-selected consumer
user, and

_____ providing a sponsor-selected geographic location for fulfillment.

12. The method of claim 11, wherein said database of awards includes awards from a plurality of sponsors.
13. The method of claim 11, wherein said providing automated fulfillment step comprises:

associating an award with the incentive program; and

associating a fulfillment method with the award.
14. The method of claim 11, wherein said providing automated fulfillment step further comprises:

providing a card comprising memory for storing data associated with a user.
15. The method of claim 13, wherein said associating a fulfillment method step comprises:

providing an optimization application program that identifies an award based on the geographic proximity of an award winner to a redemption location of an award in the database of awards.

16. The method of claim 14, wherein said data is a personal identification number.

17. The method of claim 14, wherein said data is information relating to a user's participation in an incentive program.

33. (Twice Amended) A system for building an incentive program having automated fulfillment, comprising:

a computer coupled to a network;

an incentive program generation application program for generating an incentive program in response to input of parameters by a user;

an award association application program for associating an award with the incentive program; and

an automated fulfillment application program for associating a fulfillment method with said award wherein said automated fulfillment program is operative to provide

sponsor-selected fulfillment comprising being:

operative to provide a sponsor-selected specific award unit item,

operative to provide said sponsor-selected specific award unit item tailored to demographic and psychographic preferences of a sponsor-selected consumer user, and

_____operative to provide a sponsor-selected geographic location for
fulfillment.

34. (Twice Amended) _____ A method of providing for generation of an incentive
program having automated fulfillment over a network, comprising:

providing a computer coupled to a network;

generating an incentive program in response to input from a user;

associating an award with the incentive program; and

associating a fulfillment method with the award, wherein at least one of generating an
incentive program, associating an award and associating a fulfillment method is
accomplished by an automated fulfillment application program, comprising

_____ providing sponsor-selected fulfillment comprising:

_____ providing a sponsor-selected specific award unit item,

_____ providing said sponsor-selected specific award unit item tailored
according to demographic and psychographic preferences of a sponsor-selected consumer
user, and

_____ providing a sponsor-selected geographic location for
fulfillment.

39. (Once Amended) _____ The system of claim 2, further comprising:

a redemption workstation associated with each of said plurality of providers
coupled to the network;

at least one of

a member management database, coupled to the network, operative to add
a member record for a new member, and

an inventory management system associated with each of said plurality of
providers coupled to said redemption workstation; and

wherein said automated award fulfillment application program is operative to
allow designation of redemption of an award including access to any inventory
management system of any of said plurality of providers and access to any member
database; wherein said automated award fulfillment application program is operative to
allow a sponsor to select said award tailored to demographic and psychographic
preferences of the consumer user stored in at least one of any of said member
management databases and said database, and to allow for sponsor-designation of
redemption of said award at a geographic location of one of said plurality of providers;
and wherein the system further comprises a sponsor computer, coupled to the network,
operative to allow a sponsor of one of said incentive programs to designate said
geographic location of redemption by the consumer user of said award.

40. (cancelled) ~~The system of claim 39, wherein said automated award fulfillment application program is operative to select said award tailored to demographic and psychographic preferences of the consumer user stored in at least one of any of said member management databases and said database, and to allow for designation of redemption of said award at a geographic location of one of said plurality of providers.~~

41. (cancelled) ~~The system of claim 40, further comprising:~~

~~a sponsor computer, coupled to the network, operative to allow a sponsor of one of said incentive programs to designate said geographic location of redemption by the consumer user of said award.~~

42. (Once Amended) The system of claim 1, wherein said plurality of providers comprise at least one of a host, a retailer, a merchant, and a sponsor.

43. The system of claim 2, wherein said browser comprises at least one of an internet browser, an automated teller machine, a kiosk, a gasoline pump, a wireless device, a personal digital assistant, and a communication device.

44. The system of claim 3, wherein said permitting access comprises at least one of:

providing for registration and interaction with content of said database and said automated award fulfillment application program.

45. The system of claim 5, wherein said fulfillment options comprise:

receiving fulfillment at a sponsor designated geographic location;

receiving online fulfillment;

receiving offline fulfillment;

receiving fulfillment at a merchant;

receiving fulfillment at a retailer; and

receiving fulfillment at point of sale (POS).

46. The system of claim 6, further comprising:

a redemption computer associated with each of a plurality of providers coupled to said network; and

at least one of:

a member database, coupled to said network, operative to add a member record for a new member, and

an inventory management system associated with each of said plurality of providers coupled to said network; and

wherein said automated award fulfillment application program is operative to allow designation of redemption of an award including access to any inventory management system of any of said providers, access to said awards database and access to at least one of any of said member databases and said database of said host computer.

47. The system of claim 46, wherein said automated award fulfillment application program is operative to select said award tailored to any demographic and psychographic preferences known of said consumer user stored in at least one of any of said member databases, and said database of said host computer, and to allow for designation of redemption of said award at a geographic location of one of said plurality of providers.

48. The system of claim 47, further comprising:

a sponsor computer coupled to the network operative to allow a sponsor of one of said incentive programs to designate said geographic location of redemption by said consumer user of said award.

49. (Once Amended) A method of automatically fulfilling an award comprising:

(a) receiving a sponsor designation of redemption of an award for a consumer user
comprising

receiving a sponsor-selected fulfillment comprising:

receiving a sponsor-selected specific award unit item,

receiving said sponsor-selected specific award unit item tailored
according to demographic and psychographic preferences of a sponsor-selected consumer
user, and

receiving a sponsor-selected geographic location for fulfillment;

(b) ~~facilitating automating~~ fulfillment of said award in accordance with said sponsor
designation of redemption.

50. The method according to claim 49, wherein said step (a) comprises:

(1) receiving a sponsor designated award selection comprising at least one
of:

(A) providing interactive access to one or more consumer databases
of at least one of a host, a provider, a sponsor, a retailer, and a
merchant, having information about a consumer user;

(B) providing interactive access to an inventory management
system of at least one of a host a provider, a sponsor, a

retailer, and a merchant, having information about award

availability; and

(C) receiving said sponsor designated award selection selected
from an award pool.

51. The method according to claim 50, wherein said step (a) (1) (C) comprises at least one of:

(i) receiving said sponsor designated award selection
from said award pool wherein said award pool
comprises a group of awards selected from an
awards database;

(ii) receiving said sponsor designated award selection
from said award pool comprising
receiving a selection from said award pool
from a plurality of sponsors as long as quantities of
awards are available;

(iii) receiving said sponsor designated award selection
comprising:

- receiving a user demographically tailored selection of said sponsor designated award tailored to at least one of demographic and psychographic preferences of the consumer user stored in any of said consumer databases;
- (iv) receiving said sponsor designated award selection comprising:
 - determining availability of said sponsor designated award in said inventory management database of said provider; and
- (v) providing an award recipient to at least one of said consumer databases.

52. The method according to claim 51, wherein said step (a) (1) (C) further comprises:

- (vi) validating said award recipient of said award to at least one of said host, said provider, said sponsor, merchant, and said retailer when said award recipient attempts to fulfill said award.

53. The method according to claim 51, wherein said step (a) further comprises:

- (2) receiving a sponsor designated geographic location for redemption of said award comprising at least one of:
 - (A) providing interactive access to a fulfillment network database having information about one or more providers; and
 - (B) receiving a sponsor designated consumer user-tailored geographical location selection from a fulfillment network.
54. The method according to claim 53, wherein said step (b) comprises:
- (1) fulfilling said award at said sponsor designated geographic location for redemption.
55. The method according to claim 49, wherein said step (a) comprises:
- (1) receiving a sponsor designated geographic location for redemption of said award comprising at least one of:
 - (A) providing interactive access to a fulfillment network database having information about one or more providers; and
 - (B) receiving a sponsor designated consumer user-tailored geographical location selection from a fulfillment network.

56. The method according to claim 55, wherein said step (b) comprises:

- (1) fulfilling said award at said sponsor designated geographic location for redemption.

57. (Once Amended) The method according to claim 49, where said step (b) comprises at least one of:

- (1) ~~facilitating-automating~~ fulfillment comprising:
 - (A) providing fulfillment using at least one fulfillment option of a plurality of fulfillment options comprising:
 - (i) ~~facilitating~~-receiving fulfillment at a sponsor designated geographic location;
 - (ii) ~~facilitating~~-receiving online fulfillment;
 - (iii) ~~facilitating~~-receiving offline fulfillment;
 - (iv) ~~facilitating~~-receiving fulfillment at a merchant;
 - (v) ~~facilitating~~-receiving fulfillment at a retailer; and
 - (vi) ~~facilitating~~-receiving fulfillment at point of sale (POS); and

(2) providing a validation of an award recipient of said award to at least one of said host, said provider, said sponsor, said retailer, and said merchant.

58. The method according to claim 50, wherein said award selection comprises an award unit.

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